

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STERLING B. BROWN,
CHORNG-FURE R. HWANG, HIROMI ISHIDA,
JAMES J. SCOBBO JR., and JOHN B. YATES III

Appeal No. 1997-0717
Application 08/405,668

ON BRIEF

Before CAROFF, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner refusing to allow claims 1 through 23 as amended subsequent to the final rejection.¹

We have carefully considered the record before us, and based thereon, find that we cannot sustain the grounds of rejection of the appealed claims under 35 U.S.C. § 103 over Kazunari et al.

¹ Amendment of April 15, 1996 (Paper No. 5).

(published European Patent Application) or Kodaira et al. or Ishida et al. in view of Reed et al. or Brown et al. (answer, pages 4-5).²

It is well settled that in order to establish a *prima facie* case of obviousness, “[b]oth the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991), citing *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Thus, a *prima facie* case of obviousness is established by showing that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge generally available to one of ordinary skill in the art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants’ disclosure. *See generally, In re Oetiker*, 977 F.2d 1443, 1447-48, 24 USPQ2d 1443, 1446-47 (Fed. Cir. 1992) (Nies, J., concurring); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276 (Fed. Cir. 1987).

There is no dispute that the thermoplastic compositions of claim 1 differ from the thermoplastic compositions of the primary references in that the former contains 0.1% by weight to about 1.0% by weight of a metal salt of an organic acid. We have carefully considered the teachings of the applied references in light of the examiner’s position that Reed et al. and Brown et al., in disclosing the use of fatty acid metal salts in thermoplastic compositions containing, *inter alia*, arylene sulfide resins and functional polyphenylene ether resins, respectively, would have reasonably suggested to one of ordinary skill in this art to successfully use fatty acid metal salts and the amount thereof specified in claim 1 in the thermoplastic compositions containing both of these resins disclosed in the primary references. Based on our review of the references, we are convinced that even though the compositions of the primary references can be modified as proposed by the examiner, the combined teachings of the applied references would have at best suggested that it would be obvious to try a fatty acid salt with those compositions, which is not the standard of § 103. Indeed, with the exception of the arylene sulfide

² The references are listed at page 3 of the answer.

resins of Reed et al. and functional polyphenylene ether resins of Brown et al., there is little, if any, commonality between the compositions of these references and those of the primary references. *Cf. In re Castner*, 518 F.2d 1234, 1238-39, 186 USPQ 213, 217 (CCPA 1975) (“[W]hen the ingredients are associated in an obvious manner set forth in the claims, they do not co-act with each other in any new or unexpected way and define nothing patentable over the prior art.”).

Thus, it is manifest that the only direction to appellants’ claimed invention as a whole on the record before us is supplied by appellants’ own specification. *Fine, supra; Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531-32.

The examiner’s decision is reversed.

Reversed

MARC L. CAROFF)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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